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PATENTS  
Attorney Docket No. PFI-816CIP  
*8.21.02*

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Orlow *et al.*

Serial No.: 09/827,428

Filing Date: April 6, 2001

Title: Methods and Compositions That Affect  
Melanogenesis

Art Unit: 1642

Examiner: A. Harris

Assistant Commissioner for Patents  
Washington, DC 20231

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CERTIFICATION UNDER 37 C.F.R. § 1.8(a)

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Assistant Commissioner for Patents, Washington, DC 20231 on the date shown below.

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*Emily R. Whelan*  
Emily R. Whelan

RESPONSE TO RESTRICTION REQUIREMENT UNDER 35 U.S.C. § 121

Hon. Assistant Commissioner for Patents:

Applicants hereby respond to the Office Action dated June 28, 2002, which detailed a Restriction Requirement under 35 U.S.C. § 121. The Action contained a five-way Restriction Requirement.

Applicants thank the Examiner for the courtesy of a telephone call to Emily Whelan on July 29, 2002. In the telephone call, the Examiner noted Applicants' traversal of the Restriction, and in particular Applicants' request that the Examiner regroup the claims of Group III, claims 44-69, and Group IV, claims 70-82 and 91-92. The Examiner declined to regroup the claims at this time. However, the Examiner indicated a

willingness to rejoin the method claims of Group III in the event that Applicants elect the composition and kit claims of Group IV and those claims are found allowable.

With this Response, Applicants again traverse the Restriction. Applicants contend that the subject matter of Groups I-V, including all of the pending claims, is related. All of the claims relate to compositions that affect melanogenesis, and methods of making and using such compositions. Therefore, search and examination of the entire application could be made without serious burden.

Accordingly, withdrawal of the Restriction Requirement with respect to Groups I-V is respectfully requested and believed to be in order.

In particular, Applicants emphasize the close relation of the subject matter of Group III, claims 44-69, and Group IV, claims 70-82 and 91-92. The claims of Group III are directed to methods of decreasing melanin production and methods of reducing skin pigmentation using "a compound that effects an alteration in late endosomal/lysosomal trafficking." The claims of Group IV are directed to pharmaceutical compositions for reducing skin pigmentation comprising "a compound that effects an alteration in late endosomal/lysosomal trafficking" (claims 70-82), and kits comprising "a compound that modulates melanogenesis by" mechanisms including "inhibiting late endosomal/lysosomal trafficking." The identity of claim language in the method claims of Group III and the composition and kit claims of Group IV indicates that the methods of Group III cannot be practiced without the compounds found in the compositions and kits of Group IV. Moreover, a search for the compositions and kits of Group IV would necessarily identify references related to the methods of Group III, and vice versa. Thus, a separate search would not be required to examine the claims of Group III along with Group IV.

Therefore, Applicants respectfully request that the Examiner regroup the subject matter of Groups III and IV. Accordingly, withdrawal of the Restriction Requirement with respect to claims 44-69 and claims 70-82 and 91-92 is respectfully requested and believed to be in order. Upon withdrawal of the Restriction Requirement with respect

to Groups III and IV, claims 44-82 and 91-92, Applicants respectfully elect to prosecute claims 44-82 and 91-92.


Nevertheless, in the event that the Examiner disagrees with the traversal and does not withdraw the Restriction, and in order to be in full compliance with the Restriction, Applicants elect to pursue Group IV, claims 70-82, 91 and 92, with traverse.

Further and favorable consideration of all the claims of record on the merits is respectfully requested.

No fees are believed to be due. However, if such a fee is due or a credit is owed, please make them to our Deposit Account No. 08-0219.

The Examiner is encouraged to telephone the undersigned at the number listed below in order to expedite the prosecution of this application.

Respectfully submitted,



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Dated: July 29, 2002

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